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EXAMINER

SUHOL, DMITRY

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 08/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/071,545

Applicant(s)

HORNSBY ET AL.

Examiner

Dmitry Suhol

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 3-4 and 6-8 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 5-9 of copending Application No. 09/966680. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 9 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-13, 33 and 43 of copending Application No. 09/931570 in view of Tachau et al (U.S. Patent No. 6,346,025). Copending application no. 09/931570 discloses all of the elements of the claims but for armor detachably carried by the body and protecting at least a portion of the body and the device being transformable. However Tachau discloses an amusement device, which teaches armor detachably carried by the body and protecting at least a portion of the body (fig. 8) and a device that is transformable (col. 19, lines 32-37).

This is a provisional obviousness-type double patenting rejection.

Claims 1-2 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 10 of copending Application No. 09/966680. Although the conflicting claims are not identical, they are not patentably distinct from each other because they set forth subject matters which are obvious over each other and only differ in breadth of terminology used. For example, "means for keying" of the application is an obvious variation in meaning of the limitation "means for holding information" in the copending application 09/966680 because they are disclosed as the same feature.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-8, 10-12, 14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the method step of “building a battle deck” can’t be determined, rendering the claim indefinite.

Regarding claim 4, the phrase “may be” is not a positive limitation, rendering the claim indefinite.

Regarding claims 10-12, the structural features encompassed by the claims can’t be determined. It is unclear what structural feature(s) define the functional attributes as claimed.

Regarding claims 14 and 16, the structural features encompassed by the phrase “a mating shape so as to prevent a second flag having a different function from being received in the engagement slot” can’t be determined. It is unclear as to what structural feature prevents a second flag from being received in an engagement slot.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Li et al. Li discloses an amusement device containing all of the elements of the claim including a body (fig. 20, element A), features carried by a body (fig. 20, elements B), armor detachably carried by a body is read onto the outer casing of the robot shown in figure 20 where it is considered that anything can be detached from something else by disassembly or simply breaking the pieces, a means for powering a device and some features carried by the body (col. 4, lines 22-26), means for holding information (fig. 1, element 10 and col. 7, lines 59-64), means for receiving information (fig. 20, element 210 and col. 7, lines 59-64) where the means for receiving information is carried by a body (fig. 20, element 210), a microprocessor operably coupled to a means for powering and a means for receiving (fig. 17, element 25 and col. 5, lines 21-23).

Claims 3-8 are rejected under 35 U.S.C. 102(b) as anticipated by Simms or Pearson et al or, in the alternative, under 35 U.S.C. 103(a) as obvious over Simms in view of Gabai et al. Pearson discloses a game method using a number of information carrying cards containing all the elements of the claims including, building a "battle" deck and distributing collectable cards to players as required by claims 3 and 8 (col. 3, lines 35-50 and figure 2), players using the game information against each other to try to achieve victory over other players as required by claim 3 (col. 3, lines 35-50 and figure 2).

Simms discloses a game method using a number of information carrying cards containing all the elements of the claims including, building a "battle" deck and distributing collectable cards to players (col. 5, lines 43-48), players using the game information against each other to try to achieve victory over other players (col. 6, lines 11-21). Simms further discloses, using information carried by cards to actuate amusement devices as required by claims 4 and 5 (abstract) where it is considered that since images are displayed on a video screen of a computer (considered to be an amusement device) there are parts that are actuated in response to reading the images. Furthermore it is considered that the computer (amusement device) acts according to and in association with control information carried on a card and games being played, as required by claims 6 and 7, since it displays images carried by the cards relating to a wrestling game.

If Simms is later deemed not to meet claims 4 and 6-8 because Simms does not disclose using information carried by cards to actuate amusement devices and amusement device acting according to and in association with control information carried on a card and games being played, then it would have been obvious to combine the teachings of Gabai of providing a doll(s) or figure(s) which is/are movably responsive to a game played on a computer (col. 9, lines 9-44) for the purpose of interest to a user and added realism.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathieu et al in view of Lebensfeld et al. Mathieu discloses an interactive amusement device containing most of the elements of the claims including, a body as required by claims 2 and 9 (fig. 1, element 22), at least two transport elements movably connected to a body as required by claim 2 (fig. 1, elements 38), at least two arms connected to a body as required by claim 2 (fig. 1), a motor associated with a body and coupled to two transport elements as required by claims 2 and 9 (fig. 6, elements 42) a microprocessor as required by claims 2 and 9 (figure 6, element 58), a wireless receiver associated with a body as required by claims 2 and 9 (fig. 8, element 64), a unit wireless transmitter associated with a body and coupled with a microprocessor as required by claims 2 and 9 (figure 1, element 20), a remote wireless transmitter operably coupled with a wireless receiver as required by claims 2 and 9 (figure 1, element 46), a function of a device is a speed of travel as required by claim 10 (col. 3, lines 26-32).

Although Mathieu discloses most of the elements of the claims the reference fails to teach arms being movably connected to a body as required by claim 2, a key receiving device as required by claims 2 and 9, a device being able to transform into at least two different forms as required by claim 2, a function of the amusement device being armor setting as required by claim 11, a function of the amusement device being



Art Unit: 3712

weapons setting as required by claim 12, a keying device being a flag having a base as required by claim 13, a base and an engagement slot having a mating shape as required by claims 14 and 16, a keying device being an attachment having a peg configured to be received in an engagement slot on a body as required by claim 15.

However, Lebensfeld discloses an interactive device, like that of Mathieu, which teaches arms movably connected to a body (col. 7, lines 31-36), a key receiving device (fig. 5, element 49 and col. 9, lines 35-39), a device being able to transform into at least two different forms (col. 10, lines 49-53) where it is considered that an addition of any accessory would be a different form of the device, a function of the amusement device being armor setting or weapons setting (col. 6, lines 28-37), a base having a peg and an engagement slot on a body having a mating shape (figure 5, elements 48 and 49).

Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to manufacture the device of Mathieu with all of the above mentioned features of Lebensfeld for the purpose of providing a low cost upgradable/changeable interactive toy with multiple functions for added play value of the user. Although Lebensfeld does not disclose a keying device being a flag it would have been obvious to make such a device a flag since Lebensfeld discloses a variety of play scenarios with using a variety of accessories (col. 10, lines 44-62). Furthermore the shape of the keying device would have been an obvious choice of design in that the applicant discloses no advantage or critical need for it (see applicant specification page 32, lines 19-21).

Claims 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathieu et al in view Li et al. Mathieu discloses most of the elements of the claims, as stated above, but for a key receiving device as required by claim 9, a data card reader and a data card discrete from a body as required by claim 17. However Li discloses an interactive amusement device in a shape of a moving robot, like the device of Mathieu, which teaches a key receiving device (fig. 20, element 210), a data card reader (fig. 19, element 251) and a data card discrete from a body (col. 7, lines 59-64). Therefore it would have been obvious, in view of Li, to manufacture the device Mathieu with the teachings of Li, as sated above, for the purpose of providing a low cost interchangeable program for providing sound and help with the movement of the device.

Claims 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld et al in view of Mathieu et al and Li et al. Lebensfeld discloses an interactive amusement device with upgradeable functions containing most of the elements of the claims, as described above. Mathieu teaches an interactive amusement device like that of Lebensfeld with the addition of remote controlled figures, as stated above. Li discloses an interactive amusement device, which teaches the use of a data card and data card reader to upgrade certain functions of a device, as stated above. Therefore it would have been obvious to combine the teachings of Mathieu and Li in order to manufacture the device of Lebensfeld with remote controllable figures, and easily upgradeable functions such as sound and movement.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ds  
August 1, 2002



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